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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,425	01/14/2004	Taketo Yoshii	742406-27	3264

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EXAMINER
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BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/756,425

Applicant(s)

YOSHII ET AL.

Examiner

Bharat N. Barot

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/548,744.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. New claims 19-26 remain for further examination.

### **The new grounds of rejection**

2. Applicants' amendments and arguments with respect to claims 19-26 filed on September 30, 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

### **Claim Objection**

3. Claim 26 is objected to because of the following informalities: Claim 26 depend on the canceled claim 1, which is a typographical error.

Appropriate correction is required.

### **Statutory Double Patenting**

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer **cannot** overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 19-25 of this application conflict with claims 10-18 of Application No. 10/721,415. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

6. Claims 19-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10-18 of copending Application No. 10/721,415. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. The subject matter claimed in the instant application is fully disclosed in the copending Application No. 10/721,415 and is covered by the copending Application No. 10/721,415 since the copending Application No. 10/721,415 and the application are claiming common subject matter, as follows:

The claimed invention in the instant application (claims 19-26) is same as the claimed invention in the copending Application No. 10/721,415 (claims 10-18) by adding the steps of receiving an application transmitted via a digital broadcast before the both steps of registering. No new invention or new improvement is being claimed in the instant application (claims 19-26).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a copending Application. [Based on 8-38] See also MPEP § 804.

**Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahmed et al (U.S. Patent No. 6,647,432).

Ahmed's patent meets all the limitations for claims 10-18 recited in the claimed invention.

10. As to claim 19, Ahmed et al teach an event sending method for a digital broadcasting receiver (ITC server) that sends an event corresponding to an input from a user (client) operation of a remote control to an application running in the digital broadcasting receiver (see abstract; figures 3 and 7; column 10 line 60 to column 11 line 32; and column 14 line 57 to column 15 line 56), comprising:

receiving a first application transmitted via a digital broadcast; registering first application determining information in the digital broadcasting receiver based on first receivable event information, the first receivable event information identifies which event corresponding to an input from the user can be received by a first application capable of executing a process based on the event identified in the first receivable event information in the digital broadcasting receiver; receiving a second application transmitted via a digital broadcast; registering second application determining information in the digital broadcasting receiver based on second receivable event information, the second receivable event information identifies which event corresponding to an input from the user can be received by a second application capable of executing a process based on the event identified in the second receivable event information in the digital broadcasting receiver (figure 7; column 14 line 57 to column 15 line 56; and column 50 line 59 to column 51 line 16);

sending the event corresponding to the input from the user to the first application when the first application determining information identifies that the event corresponding to the input from the user can be received by the first application; and sending the event corresponding to the input from the user to the second application when the second application determining information identifies that the event corresponding to the input from the user can be received by the second application (figures 8-11; and column 15 line 57 to column 17 line 56).

11. As to claims 20-21, Ahmed et al teach that the first application alters the first application determining information based on a running status of the first application; and the second application alters the second application determining information based on a running status of the second application (figures 12-15; and column 17 line 57 to column 24 line 10).

12. As to claims 22-26, they are also rejected for the same reasons set forth to rejecting claims 19-21 above, since claims 22-25 are merely an apparatus for the method of operation defined in the claims 19-21 and claim 26 is merely a program product for the method of operation defined in the claims 19-21.

#### **Response to Arguments**

13. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

14. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**Contact Information**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.



**BHARAT BAROT  
PRIMARY EXAMINER**

Patent Examiner Bharat Barot

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November 30, 2005